UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,138	04/23/2001	Masaki Hiraga	1341.1091/JDH	1608

21171   7590   02/24/2009

STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER
NGUYEN, TRI V

ART UNIT	PAPER NUMBER
1796	

MAIL DATE	DELIVERY MODE
02/24/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 December 2008*.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8,11-13 and 16* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-8,11-13 and 16* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____ .

DETAILED ACTION

Response to Amendment

1. Upon the amendment filed on 12/09/08, Claims 1, 11-13 and 16 are amended and Claims 9,

10, 14, 15, 17-23 are cancelled. The currently pending are Claims 1-8, 11-13 and 16.

2. Applicant's arguments and amendments filed on 12/09/2008 have been fully considered but

they are not persuasive. Furthermore, a new ground of rejection has been set forth below.

Claim Rejections - 35 USC § 103

3.   The text of those sections of Title 35, U.S. Code not included in this action can be found

in a prior Office action.

4. Claims 1-3, 8, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Ng in view of Davis et al. or Beriker et al. (US 2006/0253434).

Ng teaches a method of allowing users to submit (corrected) searches on products and

receive rewards once a second user utilizes the original search. The overall scheme is funded

via advertisements.

Claim 1: Ng discloses a method of providing points based on a retrieval of keywords, the

method comprising:

> a. presenting a first set of keywords from a provider to a first user through a network
>
> (col 6, lines 37 - 45 -- the presentation of categories for products is commensurate to the
>
> presentation of keywords);
>
> b. accepting, from the first user, a selection of at least one of the first set of keywords
>
> presented (col 6, lines 37 - 45);
>
> c. registering at least one keyword selected by the first user (col 5, line 21 to col 6, line
>
> 51);

d. storing, in a first table, the at least one registered keyword and the first user who has

made the selection (col 5, line 21 to col 6, line 51—the products/services reviewed are

considered as the keywords);

e. presenting a second set of keywords from the provider to an advertiser through the

network;

f. accepting, from the advertiser, a selection of at least one of the second set of

keywords;

g.   storing, in a second table, the at least one keyword selected by the advertiser;

h. in response to a reception of a request for the search from the second user different

from the first user through the network, searching the first table and the second table for

keywords specified in the request for the search, and when any of the specified

keywords is found both in the first table and the second table, sending results of the

search along with an advertisement associated with the at registered least one keyword

in the first table to the second user through the network (col 8, lines 33-49);

i.   displaying the results and the advertisement on a display screen of the second user's

terminal; and

j.   giving points to the first user when the second user has referred to the advertisement

by clicking the advertisement on the display screen, by storing the points as related to

the first user in a third table which keeps point information for each user (col 8, lines 33-

49).

Ng does not explicitly disclose the database management and the steps of interacting

with the advertiser and displaying the advertisement along with the search results. Ng discloses

the use of databases and targeted advertising in conjunction with the products and services

listed and searched (col 15, lines 43-60). Furthermore, Ng teaches the feature of a user being

rewarded for an advertisement being viewed by a second user (col. 14, lines 52-63 and claim 4). Official notice is taken that it would have been well within the purview of a skill artisan at the time of the inventions to implement the method to a database architecture. In an analogous art, Davis et al or Beriker et al. recites the features of targeted advertisement being displayed on a search result web page and specific keywords being presented and selected by the advertiser (Davis: abstract, Figs 1, 2 , 9 and parag. 48- 60 & Beriker et al: abstract, Figs 10A, B, 13, 14, § 29, 60-70). It is noted that, in the broadest reasonable interpretation of the instant claims, Ng teaches a first user being presented a category listing (a keyword), the first user further provides information about a product associated with the selected category and is rewarded once a second user has viewed the information regarding the product listed in the category - thus the category is an underlying keyword that is selected by the first user and is not seen as being diverging from the concept of a keyword having to be the product. It would have been obvious to a skilled artisan to further expand the category listing to arrive at specific item. Also, the advertising features is taught by Ng - see claim 4 wherein a person is rewarded for advertisement viewed; col 14, line 53 et seq. in which advertising revenue are used to fund the database and col 15, line 43 et seq. in which targeted advertising is implemented. It would have obvious to a skilled artisan at the time the invention was made that a consumer interested in a specific brand of products and categories would inputs brands, products and/or in a search engine and that the entries are keywords and that the advertiser would sponsor its own products. Furthermore, the Davis et al. or Beriker et al reference is relied upon to teach the association of keywords and advertisements with advertising revenues being generated via click-throughs.

A second reasonable interpretation of the instant claims is also taught by Ng in which a user is rewarded for correcting the entries regarding a product. Here, the user is presented a

list of products (or keywords), select one that the user wants to correct and is rewarded if

another user view the corrected information. Again, the advertising features are taught by Ng

and Davis et al. or Beriker et al.

Therefore, it would have been obvious to one having ordinary skill in the art at the time

the invention was made to modify the method as taught by Ng with keyword-based advertising.

One would have been motivated to optimize the efficiency of the targeted advertisement by

focusing the selection and ensuing delivery of the advertisement to users who are more likely to

purchases the items advertised. The claim would have been obvious because a particular

known technique was recognized as part of the ordinary capabilities of a skilled artisan. The

claim would have been obvious because the technique for improving a particular method was

part of the ordinary capabilities of a person of ordinary skill in the art, in view of the teaching of

the technique for improvement in other situations.

Claim 2: Ng and Davis et al or Beriker et al disclose the method of providing points according to

claim 1, wherein the points gained by the first user are exchanged for a product or a service

(Ng: col 9, lines 23-29).

Claim 3: Ng and Davis et al or Beriker et al disclose the method of providing points according to

claim 1, wherein the points given to the first user comprise user points that are generated when

the result of the search using the specified keywords is sent and advertiser points that are

generated when the second user has referred to the advertisement (Ng: col 5, lines 4-9). In an

analogous art, Davis et al. or Beriker et al also disclose the rewarding based on the number of

click-throughs (Davis et al: § 11, 13, 96 and 98 & Beriker et al: § 60-70). It would have been

obvious to one having ordinary skill in the art at the time the invention was made to modify the

method as taught with an accounting system via a per view basis. The claim would have been obvious because a particular known technique was recognized as part of the ordinary capabilities of a skilled artisan.

Claim 8: Ng and Davis et al or Beriker et al disclose the method of providing points according claim 1, but do not explicitly disclose wherein a user who has registered at least one keyword can select a display on a user's terminal or a transmission by e-mail as a method of presenting the advertisement to the other users. Davis et al discloses the use of web page as a display means (Davis et al: abstract and § 48 & Beriker et al:§ 60-70). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Ng and Davis et al or Beriker et al, with displaying the advertisement via a web page since it was known in the art that different display channels are used to enhance the ways to reach the users. The claim would have been obvious because a particular known technique was recognized as part of the ordinary capabilities of a skilled artisan.

Claims 12 and 13 disclose the apparatus and the computer readable medium of the method Claim 1 respectively. The prior art of Ng and Davis et al or Beriker et al as set forth above in Claim1 is relied upon to reject Claims 12 and 13.

5. Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ng and Davis et al or Beriker et al as applied to claim 1 above, and further in view of Marks et al.

Claims 4-7: Ng and Davis et al or Beriker et al disclose the method of providing points according to claim 1, but do not explicitly disclose the various ways of charging for the keywords. Ng recites the use of heuristic rules to improve the obtained results (col 11, lines 43-

60). Davis et al or Beriker et al disclose an accounting manager to maintain the records of the transactions and the compensation information (Davis et al: abstract, element 22 in Fig 1 and Fig 2 & Beriker et al: § 60-70). In an analogous art, Marks et al. recites the use of keyword advertising by associating an ad with specific keywords chosen by the advertiser in a search engine setting that includes different charged rates for each keyword (page 2, parag. 23-28). Furthermore, the fee structure is seen as a design decision which is given little, if any, patentable weight. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Ng and Davis et al or Beriker et al to include a fee structure for charging the keywords. One would have been motivated to implement a payment scheme in order to attract advertisers by giving the advertisers a decision choice depending on the revenue, viewing experience and traffic stream pattern. The claim would have been obvious because a particular known technique was recognized as part of the ordinary capabilities of a skilled artisan.

6. Claims 11 are 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ng in view Davis et al. or Beriker et al

Claim 11: Ng discloses a method of providing points based on a retrieval of keywords, the method comprising:

    a. Presenting keywords from a provider to a first user through a network (col 6, lines 37 - 45);

    b. Accepting, from the first user, at least one keyword selected by the first user, the selected at least one keyword being associated with an advertising and an advertiser (col 6, lines 37 - 45);

    c. Registering the at least one keyword selected by the first user (col 6, lines 37 - 45);

    d. In response to a reception of request for a search from a second user, the second

user being different from the first user, displaying retrieved results the search with an

advertisement of an advertiser associated with the at least one registered keyword at

the second user's terminal (col 6, lines 37 - 45); and

    e. When the second user follows a link set to the advertisement to visit an advertiser's

site of the advertisement, giving points to the first user (col 6, lines 37 - 45);

Ng discloses the use of databases and targeted advertising in conjunction with the

products and services listed and searched (col 15, lines 43-60). Furthermore, Ng teaches the

feature of a user being rewarded for an advertisement being viewed by a second user (col. 14,

lines 52-63 and claim 4). Official notice is taken that it would have been well within the purview

of a skill artisan at the time of the inventions to implement the method to a database

architecture. In an analogous art, Davis et al or Beriker et al. recites the features of targeted

advertisement being displayed on a search result web page and specific keywords being

presented and selected by the advertiser (Davis: abstract, Figs 1, 2 , 9 and parag. 48- 60 &

Beriker et al: abstract, Figs 10A, B, 13, 14, § 29, 60-70). It is noted that, in the broadest

reasonable interpretation of the instant claims, Ng teaches a first user being presented a

category listing (a keyword), the first user further provides information about a product

associated with the selected category and is rewarded once a second user has viewed the

information regarding the product listed in the category - thus the category is an underlying

keyword that is selected by the first user and is not seen as being diverging from the concept of

a keyword having to be the product. It would have been obvious to a skilled artisan to further

expand the category listing to arrive at specific item. Also, the advertising features is taught by

Ng - see claim 4 wherein a person is rewarded for advertisement viewed; col 14, line 53 et seq.

in which advertising revenue are used to fund the database and col 15, line 43 et seq. in which

targeted advertising is implemented. It would have obvious to a skilled artisan at the time the invention was made that a consumer interested in a specific brand of products and categories would inputs brands, products and/or in a search engine and that the entries are keywords and that the advertiser would sponsor its own products. Furthermore, the Davis et al. or Beriker et al reference is relied upon to teach the association of keywords and advertisements with advertising revenues being generated via click-throughs.

A second reasonable interpretation of the instant claims is also taught by Ng in which a user is rewarded for correcting the entries regarding a product. Here, the user is presented a list of products (or keywords), select one that the user wants to correct and is rewarded if another user view the corrected information. Again, the advertising features are taught by Ng and Davis et al. or Beriker et al.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Ng with keyword-based advertising. One would have been motivated to optimize the efficiency of the targeted advertisement by focusing the selection and ensuing delivery of the advertisement to users who are more likely to purchases the items advertised. The claim would have been obvious because a particular known technique was recognized as part of the ordinary capabilities of a skilled artisan. The claim would have been obvious because the technique for improving a particular method was part of the ordinary capabilities of a person of ordinary skill in the art, in view of the teaching of the technique for improvement in other situations.

Claim 16 discloses the computer readable medium of the method Claim 11. The prior art of Ng and Davis et al or Beriker et al set forth above in Claim 11 is relied upon to reject Claim 16.

Response to Arguments

7.   Applicant's arguments filed 12/09/2008 have been fully considered but they are not

persuasive.

Applicants argue that the category listing is not commensurate to a keyword and the

association of advertiser to keyword (page 8 et seq.) and that Ng does not teach the feature of

sending the advertisement results along with search results (page 10), the examiner respectfully

notes that Ng teaches the display of the result of keyword queries and the cited references of

Davis et al or Beriker et al. is relied upon to the feature of displaying advertisements associated

with registered keywords and that Ng and Davis et al. or Beriker et al references disclose the

features of a search engine and search terms input thus the search term is construed as a

keyword.   Furthermore, Davis et al. or Beriker et al teach the advertisers register/buy specific

keyword entries and are charged for displaying advertisements associated with the keywords. It

is also noted that, in a broad and reasonable interpretation of the instant claims, Ng teaches a

first user being presented a category listing (a keyword), the first user further provides

information about a product associated with the selected category and is rewarded once a

second user has viewed the information regarding the product listed in the category - thus the

category is an underlying keyword that is selected by the first user and is not seen as being

diverging from the concept of a keyword having to be the product. Furthermore, the advertising

features is taught by Ng - see claim 4 wherein a person is rewarded for advertisement viewed;

col 14, line 53 et seq. in which advertising revenue are used to fund the database and col 15,

line 43 et seq. in which targeted advertising is implemented. It would have obvious to a skilled

artisan at the time the invention was made that a consumer interested in a specific brand of

products and categories would inputs brands, products and/or in a search engine and that the

entries are keywords and that the advertiser would sponsor its own products. Furthermore, the

Davis et al. or Beriker et al reference is relied upon to teach the association of keywords and advertisements with advertising revenues being generated via click-throughs.

A second reasonable interpretation of the instant claims is also taught by Ng in which a user is rewarded for correcting the entries regarding a product. Here, the user is presented a list of products (or keywords), select one that the user wants to correct and is rewarded if another user view the corrected information. The advertising features are taught by Ng and Davis et al. or Beriker et al. It is also noted that specific entries are taught by Davis et al (see fig 7) or Beriker et al (Fig 10A,B).

Conclusion

8.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Nakamura et al. (US 6591248) teach the feature of banner advertisement selection and display along a search result.

Emens et al. (US 7076443) teach the feature of advertisement based on keyword retrieval.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TRI V. NGUYEN whose telephone number is (571)272-6965. The examiner can normally be reached on M-F 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119 and Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. V. N./
Examiner, Art Unit 1796
February 24, 2009

/Eric W. Stamber/
Supervisory Patent Examiner, Art Unit 3622